

REMARKS

The Amendments

The claims are amended to address the sole remaining ground of rejection under 35 U.S.C. §112, as discussed below.

Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The Rejection under 35 U.S.C. §112, first paragraph

The rejection of claims 1, 12, 13, 15-17 and 19 under 35 U.S.C. §112, first paragraph, is believed to be addressed and overcome by the above amendments.

The claims were rejected on the basis that there was no support for the previously recited proviso in claims 1 and 2. As correctly stated in the Office action, the specification did not provide a specific recitation of compounds where the R¹ group is 2,5-dimethyl-3-thienyl. The rejection was thus made on the basis that, absent a recitation of the embodiment, there is no support for exclusion of the embodiment. Applicants believe such a grouping would have been reasonably conveyed to one of ordinary skill in the art from the disclosure and, thus, adequately described under 35 U.S.C. §112, first paragraph, for the purposes of excluding it by proviso. However, to advance prosecution on the subject matter which appears to be clearly allowable in view of the prosecution herein, the claims have been amended so that the proviso recites embodiments specifically recited in the disclosure. The new recitation is “provided that R¹ is not

3-thienyl substituted by both R³ and R⁴ where both R³ and R⁴ are methyl.” The specification specifically recites that one preferred selection for R¹ is “3-thienyl” (see, e.g., page 4, line 28) and that, in all cases, the R¹ group can be substituted by R³ and R⁴ (see, e.g., page 4, lines 20-21). The specification also specifically recites that one of the two most preferred groups for R³ and R⁴ is methyl (see, e.g., page 6, lines 4-5). Given these disclosures, one of ordinary skill in the art would immediately envisage the embodiment where R¹ is 3-thienyl substituted by both R³ and R⁴ where both R³ and R⁴ are methyl. Certainly, such an embodiment would be reasonably conveyed to one of ordinary skill in the art; see, e.g., Fujikawa v. Wattanasin, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996), supporting that written description is not a strict standard but one requiring that the disclosure need only "reasonably convey" to those in the art that the inventors possessed the invention. Thus, the embodiment is supported under 35 U.S.C. §112, first paragraph, and, correspondingly, the proviso is supported.

For the above reasons, the rejection under 35 U.S.C. §112, first paragraph, should be withdrawn.

Request for Rejoinder

As to the restriction between the compounds and preparation processes, reference is made to the decisions in In re Ochiai, 37 USPQ2d 1127 (Fed. Cir. 1995), and In re Brouwer, 37 USPQ2d 1663 (Fed. Cir. 1996). The Commissioner's comments thereon in 1184 TMOG 86, March 26, 1996, indicate that, where product and process claims in the same application have been restricted and the elected product claim has been found allowable, withdrawn process claims including the limitations of the allowed product claim will be rejoined into the application

and fully examined in that same application. If the compounds are novel and nonobvious, it logically follows that the method for making those compounds would be novel and nonobvious, i.e., if the compounds are not known or suggested, there is no motivation to provide a method for making them. It would appear that the product claims are now allowable. Therefore, the process claims, which are amended to require the particulars of the allowable product claims, should be rejoined for allowance therewith.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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